

## **REMARKS**

### **Claim Rejections Under 35 USC § 112 and 101**

The rejections to the forms of the claims are moot in view of the amendments.

### **Claim Rejections Under 35 USC § 102**

The elements of claim 6 are incorporated into claim 1. Claim 6 was not rejected under section 102. For this reason at least, the rejection should be withdrawn.

### **Claim Rejections Under 35 USC § 103**

The processes claimed, including that of claim 1, which now contains the elements of claim 6, are not obvious over the cited art.

As stated in the Office Action, Sumimoya et al. is drawn to a treatment method for LCDs. According to this document, LCDs are processed in a furnace and the products (only of the LCDs) are separated into glass, metal, electronic parts and tar.

In contrast to said disclosure, the process of the claimed invention is directed to a process where the LCDs are mixed with a composition which comprises a mixture of noble and non-noble metals to separate the noble from the non-noble metals of the mixture (not of the LCDs or not only of the LCDs). Such mixtures are, as recited in pending claims 21 and 22 are ores, catalysts, electrical or electronic scrap as well as metal-containing sludges.

Such a process is not obvious from the cited prior art.

Moreover, the Office Action takes the broad teaching of Sumimoya et al. of taking out gold and other metals from electronic parts as rendering claim 6 obvious, which recited the principle that LCDs are employed in order to bind the non-noble metals present in the metal-containing products and to separate them from the noble metals. No such binding action of the LCDs are taught or even remotely suggested by the cited art.

Instead, in paragraphs 19 and 20, it is taught that the temperature used is low enough to turn the resin parts of the LCDs into a tar material, whereby the glass, aluminum containing alloy, copper, and gold parts do not fuse. Thereafter in further separation techniques the non-fused various metal and glass pieces are further separated from each other, e.g., by viewing and further processing techniques. See, e.g., paragraph 26. Sumimoya et al. even warns against reaching a temperature high enough to melt the glass and metal parts as such would make them one with the carbonized plastic. See, e.g., paragraph 20, especially the end of said paragraph, teaching that "it is necessary to make it below the temperature that

neither glass nor metal fuses.” Compare this, for example, to claim 2, and also to claim 1, which recites that the mixture is melted.

Regarding claims 10-12, please consider the following.

The combination of these references is not obvious to one of ordinary skill in the art.

The first reference to Kaida teaches the disposal of LCDs by feeding to a nonferrous smelting furnace. The objective is to eliminate or destroy the product, i.e., incinerate.

The secondary reference US ‘403 has nothing to do with LCDs, or the elimination or recycling of product, or with any issues or problems of concern in the primary reference. Instead, it relates to pigments and teaches that in certain types of furnaces the “processes have the disadvantage that they make it very difficult to obtain a consistent quality of product, since it is virtually impossible to obtain a uniform temperature over the entire layer thickness.” To solve this problem, rotary furnaces are proposed as they do not have the above disadvantages.

However, no such issues discussed in US ‘403 are present in Kaida. There is no product that needs to be of consistent quality. The uniformity of the temperature is not even remotely a consideration. As such, one of ordinary skill in the art would find the disclosure of US ‘403 completely irrelevant to anything in Kaida. As such, one of ordinary skill in the art would not have a reason to combine these references.

For a combination of references to render a claimed invention obvious, there must be some reason for the combination. It is not enough that a combination of prior art references disclose all of the elements of an invention. See *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The facts of *Jones* are particularly relevant here. In *Jones*, the primary reference taught dicamba in its free acid, ester, and salt forms as herbicides, which was combined with two secondary references teaching substituted ammonium salts made from a known amine. The PTO position was that one skilled in the art would have been motivated to use, with dicamba, substituted ammonium salts made from the known amine, and would have expected such a salt to have herbicidal activity. The Federal Circuit disagreed stating “before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Not finding motivation, the PTO was reversed.

The situation is similar here. Even if the combination would lead to the claimed invention, which is not admitted, without any reason within the grasp of one of ordinary skill in the art to make the combination, there cannot be obviousness.

Reconsideration is respectfully and courteously requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908  
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Boulevard, Suite 1400  
Arlington, VA 22201  
Direct Dial: 703-812-5331  
Facsimile: 703-243-6410  
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